

REMARKS

It is noted that the PAIR database incorrectly indicates that the office action mailed July 27, 2005 is an *Ex Parte Quayle* action, when in fact the present office action includes substantive issues. The examiner is respectfully requested to have the PAIR database corrected.

Claims 1 – 9 are pending. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1, 6 and 7 were objected to for various informalities. Claims 1 and 7 have been carefully reviewed and revised to correct the informalities identified in the office action. Support for the amended wording can be located in, for example, FIG. 1 of the application as filed. In view of the amended claims, the examiner is respectfully requested to withdraw the objection.

Claims 1 – 9 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 4,538,556, Takeda (“Takeda”) in view of U.S. Patent No. 6,517,595, Kino et al. (“Kino”). The rejection is respectfully traversed for reasons including the following, which are provided by way of example.

As described in the application, the invention recognizes the problem of providing “an air intake apparatus in which a high noise suppressing effect can be secured regardless of the existence of occurrence of a lower resonance mode corresponding to the whole length of an intake air passageway.” (Specification, page 4, lines 15 – 19.) Independent claim 1 recites in combination, for example, “an air-permeable member disposed to block a communicating path disposed in a wall of the intake air passageway;” that “the wall is configured to surround an antinode of a lower resonance mode inside the air cleaner, the lower resonance mode corresponding to the whole passageway length of the intake air passageway;” and “a valve, disposed in the wall, for opening the communicating path, to allow the inside of the intake air

passageway to communicate with the outside thereof...” (See claim 1; see also claim 7.)

Thereby, one or more embodiments can be particularly effective in suppressing sound pressure of the transmitted noise by the valve closing the communicating path. (E.g., specification page 26, lines 2 - 6.)

To properly reject a claimed invention, the examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Furthermore, the teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995).

Where, as here, the examiner fails to establish a *prima facie* case of obviousness, the applicant has no burden to rebut the rejection of obviousness with evidence. *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The applicants provide herein a selection of some examples of limitations in the claims which are neither taught nor suggested by Takeda. Takeda completely fails to teach or suggest an air permeable member disposed in a wall of the intake air passageway.

Takeda also fails to teach or suggest that the wall is configured to surround an antinode of a lower resonance mode inside the air cleaner. Takeda has no discussion of antinodes or resonance modes, and therefore does not teach or suggest a configuration with respect to an antinode.

Moreover, Takeda completely fails to teach or suggest a valve in the wall, allowing the inside of the intake air passageway to communicate with the outside thereof at least when the lower resonance mode occurs. Takeda has not discussion of resonance modes, and therefore does not teach or suggest opening a valve during the occurrence of any mode. To the contrary, it appears that Takeda's valve is controlled by a vacuum diaphragm actuator (col. 2, lines 37 – 50).

The final Office Action admits that Takeda “does not employ an air permeable member or discuss the placement of the antinodes.” (Final Office Action, ¶ 6). Recognizing that Takeda fails to teach and/or suggest the invention as claimed, Kino is cited to remedy the deficiencies.

Nevertheless, Kino fails to remedy such deficiencies. For example, Kino does not teach or suggest a “wall configured to surround an antinode of a lower resonance mode inside the air cleaner.” It is noted that the office action does not allege that any reference discloses the air permeable member formed in the wall which surround an antinode that can exist inside the air cleaner.

Hence, Takeda and Kino, alone or in combination, fail to teach or suggest the combination of features recited in independent claim 1, when considered as a whole.

Moreover, the office action fails to provide a motivation for modifying the combination of Takeda and Kino with respect to the placement of the antinode. It appears that the Office Action cites Kino as disclosing this limitation, however, Takeda is clearly deficient considering

the antinode or lower resonance mode. Consequently, the proposed combination fails to teach or suggest the claimed invention.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1 and 7, but also because of additional features they recite in combination.

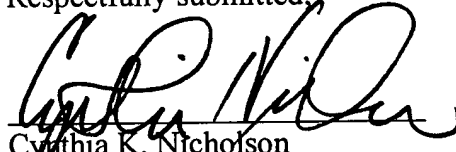
The applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. The applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, the applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

The applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples the applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,



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